



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,566	11/24/2003	John D. Bixler	118445-00105	1883
27557 7590 08/21/2008				
BLANK ROME LLP				
600 NEW HAMPSHIRE AVENUE, N.W.				
WASHINGTON, DC 20037				
EXAMINER				
RAJ, RAJIV J				
ART UNIT		PAPER NUMBER		
3626				
MAIL DATE		DELIVERY MODE		
08/21/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/718,566

**Applicant(s)**

BIXLER, JOHN D.

**Examiner**

RAJIV J. RAJ

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 24 November 2003, 27 October 2004, 15 February 2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 24 November 2003.
2. Claims 1-17 are currently pending and have been examined.

### **Priority**

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### **Information Disclosure Statement**

4. The Information Disclosure Statements filed 24 November 2003, 27 October 2004, & 15 February 2006 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

### **Claim Rejections - 35 USC § 101**

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall into one of the statutory categories: process, machine, manufacture, composition of matter or an improvement thereof. Replacing the words *computer program product that includes a medium readable by a processor* with "computer executable program tangibly embodied on a computer readable medium" is a suggestion for how to bring these claims into compliance with 35 U.S.C. 101 because "a computer-executable program tangibly embodied on a computer readable medium" is statutory subject matter.

Art Unit: 3626

7. Claims 10-16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 10-16 fail to meet the above requirements because the limitations fail to be tied to another statutory class of invention. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

### Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3626

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
10. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goknar (US 6120440) (hereinafter Goknar) in view of Dean (US 7008378 B2) (hereinafter Dean).
11. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claim 1**

Goknar as shown discloses the following limitations:

- *receive and record numerical ranking information input by the user relating to each of the signs and symptoms for each the assessment forms; (see at least Goknar Claim:4(c) & Fig: 1A & related text)*
- *a third sequence of instructions which, when executed by the processor, causes the processor to compile and output a graphical representation of each the assessment forms; (see at least Goknar Fig:1A, 4A-B & related text)*
- *a fourth sequence of instructions which, when executed by the processor, causes the processor to evaluate the numerical ranking of each of the signs and symptoms; (see at least Goknar Column:2 Lines:57-60 & Column:3 Lines:9-15)*

Goknar does not disclose the following limitations, however Dean, as shown does:

Art Unit: 3626

- *a first sequence of instructions which, when executed by the processor, causes the processor to request patient information for an autistic patient from a user, and then to record the information entered by the user; (see at least Dean Fig:10 Items:122,124 & related text)*
- *a second sequence of instructions which, when executed by the processor, causes said processor to output a plurality of assessment forms having a checklist of patient signs and symptoms; (see at least Dean Fig:1 Item:12 Fig:10 Items:10,118 & related text)*
- *to output critical treatment issues and suggested treatment methods for the treatment issues based on the evaluation of the numerical rankings; (see at least Dean Fig:10 Items:126-138)*

It would have been obvious to one of ordinary skill in the art to add the features of Dean into Goknar. One of ordinary skill in the art would have added these features into Goknar with the motivation to provide a more effective and efficient process for monitoring and prioritizing patient symptoms and characteristics in order to develop more effective treatment plans. (see at least Dean Column:4 Lines:10-21)

**Claim 2**

The combination of Goknar/Dean disclose all the limitations of Claim 1. Goknar further discloses the following limitation:

- *assessment forms further comprise a checklist of behaviors and observations related to the autistic patient's strengths; (see at least Goknar Column:5 Lines:57-67 & Column:6 Lines:1-5)*

**Claim 3**

The combination of Goknar/Dean disclose all the limitations of Claim 1. Goknar further discloses the following limitation:

- *assessment forms further comprise a checklist of signs and symptoms related to a plurality of core domains, one of the core domains being danger awareness, including safety issues and aggressiveness issues; (see at least Goknar Column:3 Lines:9-15)*

**Claim 4**

The combination of Goknar/Dean disclose all the limitations of Claim 3. Goknar further discloses the following limitation:

- *core domains includes signs and symptoms related to emotional development; (see at least Goknar Column:3 Lines:9-15)*

**Claim 5**

The combination of Goknar/Dean disclose all the limitations of Claim 3. Goknar further discloses the following limitation:

- *said core domains includes signs and symptoms related to cognitive development; (see at least Goknar Column:3 Lines:9-15)*

**Claim 6**

The combination of Goknar/Dean disclose all the limitations of Claim 3. Goknar further discloses the following limitation:

- *said core domains includes signs and symptoms related to relational and social development; (see at least Goknar Column:3 Lines:9-15)*

**Claim 7**

The combination of Goknar/Dean disclose all the limitations of Claim 3. Goknar further discloses the following limitation:

- *core domains includes signs and symptoms related to play development; (see at least Goknar Column:3 Lines:9-15)*

**Claim 8**

The combination of Goknar/Dean disclose all the limitations of Claim 1. Dean further discloses the following limitation:

- *a fifth sequence of instructions which, when executed by the processor, causes the processor to record information relating to the autistic patient's family values; (see at least Dean Fig:4 Item:58 & related text)*

Examiner interprets *family values*, as part of "Family Histories", as cited in the prior art.



Art Unit: 3626

It would have been obvious to one of ordinary skill in the art to add the features of Dean into Goknar/Dean. One of ordinary skill in the art would have added these features into Goknar/Dean with the motivation to provide a more effective and efficient process for monitoring and prioritizing patient symptoms and characteristics in order to develop more effective treatment plans. (see at least Dean Column:4 Lines:10-21)

12. Claims 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goknar in view of Dean in further view of Iliff (US 6234964 B1) (hereinafter Iliff).

**Claim 9**

The combination of Goknar/Dean disclose all the limitations of Claim 1. Goknar further discloses the following limitation:

- *second sequence of instructions includes a checklist of patient signs and symptoms relating to danger awareness encompassing safety issues and aggressiveness issues;* (see at least Goknar Column:3 Lines:9-15)
- *the computer program product further comprising a sixth sequence of instructions which, when executed by the processor, causes the processor to calculate mean numerical values for the danger awareness signs and symptoms;* (see at least Goknar Column:6 Lines:61-67 & Column:7 Lines:1-4)

Goknar does not disclose the following limitations, however Dean, as shown does:

- *output warnings related to dangers when the mean numerical values exceed threshold values;* (see at least Iliff Column:26 Lines:48-67)

It would have been obvious to one of ordinary skill in the art to add the feature of Iliff into Goknar/Dean. One of ordinary skill in the art would have added this feature into Goknar/Dean with the motivation of providing an improved method for assessing a patients symptoms and creating a optimal treatment therapy for the patient. (see at least Iliff Column:2 Lines:44-48)

**Claim 10**

Goknar as shown discloses the following limitation:

- *evaluating and recording the autistic patient's signs and symptoms in a plurality of core domains of developmental areas;* (see at least Goknar Column:2 Lines:57-60 & Column:3 Lines:9-15)

Goknar does not disclose the following limitations, however Dean, as shown does:

- *generating and recording a treatment plan template addressing critical treatment issues based upon the median numerical ranking of the core domains;* (see at least Dean Fig:10 Items:122-140 & related text)
- *(e) editing the treatment plan template to formulate a treatment plan;* (see at least Dean Fig:10 Items:133-144 & related text)
- *(f) treating the autistic patient in accordance with the treatment plan;* (see at least Dean Fig:10 Items:128,142 & related text)

It would have been obvious to one of ordinary skill in the art to add the features of Dean into Goknar. One of ordinary skill in the art would have added these features into Goknar with the motivation to provide a more effective and efficient process for monitoring and prioritizing patient symptoms and characteristics in order to develop more effective treatment plans. (see at least Dean Column:4 Lines:10-21)

Goknar and Dean do not disclose the following limitations, however Iliff, as shown does:

- *evaluating and recording the autistic patient's strengths, including assigning a numerical ranking to each strength;* (see at least Iliff Column:17 Lines:31-61, Fig:9 & related text)
- *assigning a numerical ranking to each of the signs and symptoms;* (see at least Iliff Fig:9 & related text)
- *generating and recording an assessment of the patient's median numerical ranking for each of the core domains;* (see at least Iliff Fig:9 & related text)

It would have been obvious to one of ordinary skill in the art to add the features of Iliff into Goknar/Dean. One of ordinary skill in the art would have added these features into Goknar/Dean with the motivation of providing an improved method for assessing a patients symptoms and creating a optimal treatment therapy for the patient. (see at least Iliff Column:2 Lines:44-48)

Art Unit: 3626

**Claim 11**

The combination of Goknar/Dean/liff disclose all the limitations of Claim 10. Goknar further discloses the following limitation:

- *evaluating strengths further comprising evaluating all strengths listed on a checklist of strength* (see at least Goknar Column:2 Lines:57-60 & Column:3 Lines:9-15)

**Claim 12**

The combination of Goknar/Dean/liff disclose all the limitations of Claim 10. Goknar further discloses the following limitation:

- *core domains comprise danger awareness signs and symptoms, including a checklist of safety issues and a checklist of aggressive issues* (see at least Goknar Column:3 Lines:9-15)

**Claim 13**

The combination of Goknar/Dean/liff disclose all the limitations of Claim 10. Goknar further discloses the following limitation:

- *core domains comprise signs and symptoms related to emotional, cognitive, relational and social, and play development;* (see at least Goknar Column:3 Lines:9-15)

**Claim 14**

The combination of Goknar/Dean/liff disclose all the limitations of Claim 10. Dean further discloses the following limitation:

- *periodically updating step (b), (c) and (d);* (see at least Dean Column:2 Lines:56-67, column:3 Lines:1-5, Fig:10 Items:133-140 & related text)

It would have been obvious to one of ordinary skill in the art to add the feature of Dean into Goknar/Dean/liff. One of ordinary skill in the art would have added this feature into Goknar/Dean/liff with the motivation to provide a more effective and efficient process for monitoring and prioritizing patient symptoms and characteristics in order to develop more effective treatment plans. (see at least Dean Column:4 Lines:10-21)

**Claim 15**

Art Unit: 3626

The combination of Goknar/Dean/Illiff disclose all the limitations of Claim 10. Dean further discloses the following limitation:

- *recording the autistic patient's family values and revising the treatment plan in light of the family values;* (see at least Dean Fig:4 Item:58, Fig:10 Items:122-138 & related text)

Examiner interprets *family values*, as part of "Family Histories", as cited in the prior art.

It would have been obvious to one of ordinary skill in the art to add the feature of Dean into Goknar/Dean/Illiff. One of ordinary skill in the art would have added this feature into Goknar/Dean/Illiff with the motivation to provide a more effective and efficient process for monitoring and prioritizing patient symptoms and characteristics in order to develop more effective treatment plans. (see at least Dean Column:4 Lines:10-21)

#### **Claim 16**

The combination of Goknar/Dean/Illiff disclose all the limitations of Claim 10. Dean further discloses the following limitation:

- *the step of formulating and recording a crisis intervention plan;* (see at least Dean Fig:10 Items:122-140 & related text)

Examiner interprets *crisis intervention plan*, as part of "treatment plan", as cited in the prior art.

It would have been obvious to one of ordinary skill in the art to add the feature of Dean into Goknar/Dean/Illiff. One of ordinary skill in the art would have added this feature into Goknar/Dean/Illiff with the motivation to provide a more effective and efficient process for monitoring and prioritizing patient symptoms and characteristics in order to develop more effective treatment plans. (see at least Dean Column:4 Lines:10-21)

#### **Claim 17**

Goknar as shown discloses the following limitations:

- *at least one computer having a processor, an area of main memory for executing program code under the direction of said processor, a storage device for storing data and program code, and a bus connecting the processor main memory and the storage device;* (see at least Goknar Fig:1 Items:104-117 & related text)

Art Unit: 3626

- *at least one relational database stored on said storage device;* (see at least Goknar Fig:1 Items:122,124,144 & related text)
- *a computer program code stored in said storage device and executing in main memory under the direction of said processor;* (see at least Goknar Column:5 Lines:23-27)
- *means for displaying a plurality of assessment forms having a checklist of patient signs and symptoms;* (see at least Goknar Fig:1 Items:110,114 & related text)
- *receiving numerical ranking information input by a user relating to each of the signs and symptoms for each the assessment forms;* (see at least Goknar Column:7 Lines:53-57)
- *means for compiling and outputting a graphical representation of said assessment forms;* (see at least Goknar Fig:1 Items:104-124 & related text)

Goknar does not disclose the following limitations, however Dean, as shown does:

- *means for requesting patient information from a user and recording the information;* (see at least Dean Fig:1 Item:28 & related text)
- *outputting critical treatment issues and suggested treatment methods for the treatment issues based on the evaluation of the numerical rankings;* (see at least Dean Fig:10 Items:126-138 & related text)

It would have been obvious to one of ordinary skill in the art to add the features of Dean into Goknar. One of ordinary skill in the art would have added these features into Goknar with the motivation to provide a more effective and efficient process for monitoring and prioritizing patient symptoms and characteristics in order to develop more effective treatment plans. (see at least Dean Column:4 Lines:10-21)

Goknar and Dean do not disclose the following limitations, however Iliff, as shown does:

- *means for evaluating the numerical ranking of each of the signs and symptoms;* (see at least Iliff Column:17 Lines:31-61, Fig:9 & related text)

It would have been obvious to one of ordinary skill in the art to add the feature of Iliff into Goknar/Dean. One of ordinary skill in the art would have added this feature into Goknar/Dean with

Art Unit: 3626

the motivation of providing an improved method for assessing a patients symptoms and creating a optimal treatment therapy for the patient. (see at least Iliff Column:2 Lines:44-48)

### **Conclusion**

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Rajiv J. Raj** whose telephone number is **571-270-3930**. The Examiner can normally be reached on Monday-Friday, 7:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Luke Gilligan** can be reached at **571.272.6770**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

Art Unit: 3626

Hand delivered responses should be brought to the **United States Patent and Trademark**

**Office Customer Service Window:**

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Date: 08/14/08

/Rajiv J Raj/ Patent Examiner Art Unit 3626

/Robert Morgan/

Examiner, Art Unit 3626